



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,563	05/10/2001	Hirokazu Uchio	B422-150	6252
26272	7590	10/05/2005		
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT 2165	PAPER NUMBER

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,563

Applicant(s)

UCHIO ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 29, 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

20

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29-June-2005 has been entered.
2. The amendment filed on 29-June-2005 has been received and entered. Claims 25-26 have been cancelled. Therefore, claims 27-32 are now pending

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
4. Claims 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Grainger et al. (U.S. Pub. No. 2002/0065675 A1).

As to claim 27, Grainger et al. discloses an information processing apparatus for accumulating technical documents relating to a patent application, comprising:

accumulation means for accumulating information about a related prior art document which has been cited by the patent office for examining the patent application and a foreign patent application corresponding to the patent application (See page 11, paragraph 0105; and see page 11, paragraph 0108); and

display control means for displaying a list of the prior art documents of a said patent application and a list of the foreign patent application corresponding to said patent application accumulated in said accumulation means in the same window (See page 12, paragraphs 0113-0116).

As to claim 28, Grainger et al. discloses

wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior document (See pages 8-9, paragraph 0085).

As to claim 29, Grainger et al. discloses

wherein said display control means displays descriptions indicating correspondence between the prior art document and a rejection reason (See page 11, paragraph 0109).

As to claim 30, Grainger et al. discloses

wherein said display control means displays a list of applications by which the prior art document has been cited relating to the prior art document (See page 13, paragraphs 0121-0123, wherein "has been cited relating" reads on "cross-reference").

As to claim 31, Grainger et al. discloses an information processing method for accumulating technical documents relating to a patent application, comprising:

accumulating information about a related prior art document which has been cited by the patent office for examining the patent application and a foreign patent application corresponding to the patent application (See page 11, paragraph 0105; and see page 11, paragraph 0108); and displaying and controlling a list of the prior art documents of a said patent application and a list of the foreign patent application corresponding to said patent application accumulated in said accumulation step in the same window (See page 12, paragraphs 0113-0116).

As to claim 32, Grainger et al. discloses a program storage medium storing a program for realization an information processing method for accumulating technical documents relating to a patent application, comprising the steps of:

a code for realizing an accumulation step of accumulating information about a related prior art document which has been cited by the patent office for examining the patent application and a foreign patent application corresponding to the patent application (See page 11, paragraph 0105; and see page 11, paragraph 0108); and

a code for realizing a displaying and controlling a list of the prior art documents of a said patent application and a list of the foreign patent application corresponding to said patent application accumulated in said accumulation step in the same window (See page 12, paragraphs 0113-0116).

Response to Arguments

5. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grainger (U.S. Pub. No. 2002/0072920 A1) teaches generating Information Disclosure Statements.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2165

Neveen Abel-Jalil
September 6, 2005


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
ART UNIT 2165